

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed on August 9, 2005. At the time of the Office Action, Claims 1-28 were pending in the Application. In the Office Action, the Examiner withdrew Claims 17-28 as being directed to a non-elected invention and rejected Claims 1-16. Applicant amends Claim 1 and cancels Claim 9 without prejudice or disclaimer. As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

Double Patenting

The Examiner provisionally rejects Claims 1-8 and 10-16 under the judicially created doctrine of obviousness-type double patenting. Specifically, Claims 1-8 and 10-16 are rejected as being unpatentable over Claim 1 of copending Application No. 09/817,353 ("353 Application") in view of U.S. 2002/0010634 A1 to Roman et al. ("*Roman*") and US 2001/0032143 A1 to Haseltine ("*Haseltine*"). Applicant stands willing to file a Terminal Disclaimer with respect to these claims in their current form upon indication of their allowability.

The Claims are Allowable over the cited References

Claims 1-6 and 10-16 are rejected under 35 U.S.C. 102(e) as being anticipated by *Roman*. Additionally, Claims 1 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Roman* in view of *Haseltine*. Because neither *Roman* nor *Haseltine* disclose, teach, or suggest each and every feature of Applicant's claims, Applicant respectfully disagrees.

Independent Claim 1, as amended, recites:

A method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of:

receiving, from a customer, a request to initiate return processing, via a web access tool associated with the customer;
displaying, to the customer via the web access tool, return information comprising a list of at least one transaction;
receiving return-related data from the customer, via the web access tool, thereby identifying a return item, the return-related data comprising a selection from the list; and
generating data for printing a return label.

Thus, Claim 1 has been amended to incorporate features previously recited in dependent Claim 9, which has now been canceled. Whether considered alone or in combination, neither *Roman* nor *Haseltine* disclose, either expressly or inherently, each and every element of independent Claim 1.

For example, Applicant respectfully submits that neither *Roman* nor *Haseltine* (nor their proposed combination) disclose, teach, or suggest “displaying, to the customer via the web access tool, return information comprising a list of at least one transaction” and “receiving return-related data from the customer, via the web access tool, thereby identifying a return item, the return-related data comprising a selection from the list,” as recited in Claim 1. Specifically, although *Roman* discloses “an intelligent Internet enabled reverse logistics processing system,” *Roman* merely discloses that a customer using the system “clicks on the “Return” or “Customer Service” selection to find the ClicReturns.com icon.” (Page 1, paragraph 14). “The system then transfers the consumer into the ClickReturns.com environment.” (Page 1, paragraph 14). According to *Roman*, the next step in the process includes asking the consumer “a series of questions about the return.” (Page 1, paragraph 15). Information obtained may include “receipt number, consumer’s name, phone number, description of the product being returned matching original transaction record collected from the step above, condition of the product, such as original packaging and working condition.” (Page 1, paragraph 15).

According to *Roman*, the ClickReturns.com system then “automatically analyzes the submitted return for fraud and abuse against a proprietary database.” (Page 1, paragraph 16). Thus, *Roman* only discloses that information is obtained from the customer using a question-answer format. *Roman* does not disclose, teach, or suggest “displaying, to the customer via the web access tool, return information comprising a list of at least one transaction,” as

recited in Claim 1. Similarly, *Roman* also cannot be said to disclose, teach, or suggest “receiving return-related data from the customer, via the web access tool, thereby identifying a return item, the return-related data comprising a selection from the list,” as also recited in Claim 1.

The deficiencies of *Roman* identified above are not cured by the additional disclosure of *Haseltine*. Rather, the return system disclosed in *Haseltine* uses “a distributed network of point-of-return affiliates who will accept the e-tailer’s returns on a walk-in basis in such associate’s brick-and-mortar store.” (Page 2, paragraph 18). When the purchaser desires to return the product, the purchaser “is informed by means of any various avenues of media, that the e-tailer participates in an association 40 such that the e-tailer has a distributed network of point-of-return affiliates 42 who will accept the return on a walk-in basis.” (Page 3, paragraph 34). Specifically, *Haseltine* states:

The point-of-return associate 42 provides walk-in processing of the primary target’s request for return. The point-of-return associate reads or otherwise enters the immediate message given by the inventive bar-coded packing slip 26. Again, the immediate message might actually be a web request for the download of the more full record of the packing slip. However gotten, the *point-of-return associate* calls up the electronic packing slip. Unlike most paper packing slips seen nowadays, this inventive electronic packing slip includes precise information if not instructions to the point-of-return associate. Such information or instructions will guide *this point-of-return associate* on how to properly authorize the return of the given product of this e-tailer.

(Page 3, paragraph 35, emphasis added). Accordingly, *Haseltine* discloses the point-of-return associate obtains an electronic packing slip in response to processing (i.e., scanning) the inventive bar-coded packing slip. There is no disclosure in *Haseltine*, however, of “displaying, **to the customer** via the web access tool, return information comprising **a list of at least one transaction**” and “receiving return-related data **from the customer**, via the web access tool, thereby identifying a return item, the return-related data comprising **a selection from the list**,” as recited in Claim 1. The recited combination of features is absent from the *Haseltine* disclosure.

As the basis for the Examiner's rejection of the recited claim language, the Examiner states that "[t]he use of a list to select a merchant is an old expedient in the art and official notice is taken thereof." (Office Action, page 5). Applicant notes the Examiner's taking of Official Notice and respectfully traverses the rejection of the claims on this basis. To the extent that the Examiner maintains this rejection based on "Official Notice," "well-known art," common knowledge, or other information within the Examiner's personal knowledge, Applicant respectfully requests that the Examiner cite a reference in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.107.

In considering the patentability of Applicant's claim, the M.P.E.P. requires that the Examiner give credence to each element recited in Applicant's claim. Specifically, the M.P.E.P. provides that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). As summarized above, Applicant's independent Claim 1 clearly recites both "displaying, to the customer via the web access tool, return information comprising a list of at least one transaction" and "receiving return-related data from the customer . . . comprising a selection from the list," as recited in Claim 1. Because the Examiner has not shown where the recited combination of elements is disclosed in the prior art, Applicant submits that the rejection of Claim 1 is improper in this case.

Dependent Claims 2-8 and 10-16 depend upon independent Claim 1 and are not obvious over the proposed *Roman-Haseltine* combination because they include the limitations of independent Claim 1 and recite additional elements that further distinguish the art. Since Claims 2-8 and 10-16 incorporate the limitations of independent Claim 1, which Applicant has shown above to be allowable, Applicant has not provided detailed arguments with respect to Claims 2-8 and 10-16. However, Applicant remains ready to do so if it becomes appropriate.

Regarding Claims 3-4 and 10-11, Applicant again notes the Examiner's taking of Official Notice and respectfully traverses the rejection of the claims on this basis. To the extent that the Examiner maintains the rejection of Claims 3-4 and 10-11 based on "Official Notice," "well-known art," common knowledge, or other information within the Examiner's

personal knowledge, Applicant respectfully requests that the Examiner cite a reference in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.107.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1, together with Claims 2-8 and 10-16 that depend from Claim 1.

The Proposed Roman-Haseltine Combination is Improper

Assuming for purposes or argument that the proposed combination discloses the limitations of Applicant's claims (which Applicant disputes above), it would not have been obvious to one skilled in the art to make the proposed *Roman-Haseltine* combination. In the Office Action, the Examiner speculates that "it would have been obvious to modify the method of *Roman et al.* to include the merchant specific return rules, the motivation being the ability to accommodate different business practices." (Office Action, page 5). Applicant respectfully submits, however, that the provided motivations do not provide a suggestion to combine these two references.

It is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). As discussed above, the very principle and purpose of the system disclosed in *Haseltine* is to provide "a distributed network of point-of-return affiliates who will accept the e-tailer's returns on a walk-in basis in such associate's brick-and-mortar store." (Page 2, paragraph 18). In contrast, the system of *Roman* is designed to provide the customer with a internet enabled reverse logistics processing system. (Page 1, paragraph 14). Specifically, the system of *Roman* provides suggestive up selling techniques such that "[w]hile the customer is processing a return, and before the transaction is complete, ClickReturns.com will immediately offer a similar replacement product for purchase or exchange from the originating retailer." (Page 2, paragraph 17). Because the objectives of the *Roman* and *Haseltine* systems are clearly inconsistent with one another, Applicant respectfully submits

that one of ordinary skill in the art at the time of invention would not have been motivated to modify *Roman* in the manner proposed by the Examiner.

Furthermore, it is improper for an Examiner to use hindsight having read the Applicant's disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The inconsistencies in *Roman* and *Haseltine*, as identified by Applicant above, evidences the Examiner's reconstruction of Applicant's claims by using hindsight to piece together disjointed portions of analogous, but inconsistent references.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1, together with Claims 2-8 and 10-16 that depend from Claim 1.

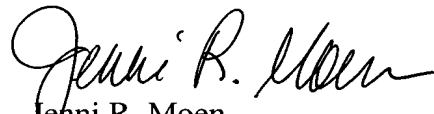
CONCLUSION

Applicant has made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further requests that the Examiner contact the undersigned attorney to schedule the telephone conference.

Applicant believes no fee is due.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant


Jenni R. Moen
Reg. No. 52,038
(214) 953-6809

Date: November 9, 2005

Customer Number: **05073**